

REMARKS/ARGUMENTS

Applicants request continued examination of the present application. On May 30, 2006, Applicants filed an Amendment After Final. On June 9, 2006 the Office issued an Advisory Action stating that the proposed amendments filed in the Amendment After Final would not be entered because they raised new issues that would require further consideration and/or search, and were not deemed to place the application in better form for appeal. In view of the following remarks and arguments, Applicants request reconsideration of the application.

In the Final Office Action, the Examiner rejected claims 1-11 and 13-22 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,704,858 to Yang in view of U.S. Patent No. 5,951,420 to Talarico and U.S. Patent No. 5,647,590 to Walker. In the Final Office Action, the Examiner noted that the basis for the rejections can be found in Office Actions mailed January 18, 2005 and August 4, 2005.

As part of this submission required under 37 C.F.R. § 1.114, Applicants present the claim amendments submitted in the Amendment After Final. Claims 12 and 19 are cancelled. Applicants also present new claims 23-35. Claims 1-11, 13-18, and 20-35 remain pending.

A. The Claims are Patentable Over Yang

1. Claim 1 is Not Obvious in View of Wang

In the Office Action dated August 4, 2005, the Examiner rejected claims 1, 6, 11, and 22 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,704,858 ("the '858 patent" or "Yang") to Yang. Applicants traverse this rejection.

To establish a *prima facie* case of obviousness, the prior art must provide a suggestion or motivation to modify the reference. MPEP § 2143.01 (8th Edition, Revision 3, August 2005). The mere fact that a reference could be modified or that a person skilled in the art might be capable of modifying the reference is not sufficient to establish *prima facie* obviousness. MPEP § 2143.01 (III), (IV). Further, there can be no suggestion or motivation to make a proposed modification if that modification would render the prior art invention unsatisfactory for its intended purpose or change the principle of operation of the invention being modified. MPEP § 2143.01 (V), (VI).

A person skilled in the art would not be motivated to modify Yang to arrive at the present claims. Yang teaches a safety baseball having a body that includes a spherical core (11) and three layers engaged on the spherical core. ('858 patent, col. 1, lines 47-49 through col. 2, lines 1-2). The first layer (12) is engaged between a core and a second layer (13), and a third layer (14) is engaged with the second layer. To reject the claims, the Examiner merely states that it would have been obvious to one of ordinary skill in the art to eliminate the first layer (12) in Yang's ball to produce a harder ball. This conclusory statement amounts to stating that Yang could be modified or that the modification would be within the capabilities of a person skilled in the art. Such statements, however, do not provide a *prima facie* case of obviousness. See MPEP § 2143.01 (III), (IV). There still must be a suggestion or motivation to modify the reference.

Even if changes from the prior art are minor, there still must be a teaching or suggestion to make such changes to produce the patentee's device. *In re Chu*, 66 F.3d 292, 298 (Fed. Cir. 1995) (citing *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 935 (Fed. Cir. 1990)). While eliminating layer 12 in Yang's baseball might seem like a minor change, there is still no suggestion or motivation to modify Yang in that manner. Yang teaches that "the safety ball in accordance with the present invention includes a first layer 12 and a third layer 14 for forming a shock absorbing layer and for forming a softer outer portion so as to prevent the players from being hurt by the baseball." ('858 patent, col. 2, lines 21-25). Yang also states that the second layer has a hardness greater than that of the first and third layers but less than that of the core "for allowing the first and the third layer to form a cushioning device." ('858 patent, col. 1, lines 28-32). That is, Yang teaches that the first and third layers in its baseball are required. Consequently, there is no teaching or suggestion to eliminate any of these layers, especially the first layer, from Yang's baseball. To modify Yang in this manner essentially amounts to prohibited hindsight in view of Applicants' disclosure.

Additionally, modifying Yang by eliminating layer 12 from Yang's baseball renders that invention unsatisfactory for its intended purpose. The purpose of Yang's invention is to provide a soft baseball. ('858 patent, col. 1, lines 19-21). Yang clearly discloses that the soft baseball is provided by the specific construction disclosed in that patent. In particular, the soft baseball is provided by the three layers engaged on the core, wherein "the intermediate layer of the three layers includes a hardness... greater than that of the other

two layers, and less than that of the core, for allowing the other two layers to form a cushioning device and for preventing the players from being hurt by the baseball.” (‘858 patent, abstract; col. 1, lines 28-32). Again, this disclosure leaves no doubt that the first and third layers are required to provide the cushioning device and thereby provide a soft baseball. Consequently, to eliminate the first or third layers in Yang would render Yang unsatisfactory for its intended purpose and/or change the principle of operation of that reference. Therefore, there is no motivation to modify Yang by eliminating the first layer, and Yang is not sufficient to render the claims obvious. MPEP § 2143.01 (V), (VII).

Further, this is not a case where omitting an element and its function from a disclosure renders another invention obvious. The Examiner stated that it would have been obvious to eliminate the layer 12 because doing such would constitute a mere elimination of a part and its associated function. To support his position, the Examiner cited *In re Karlson*, 136 USPQ 184 (CCPA 1963), and *In re Wilson and Benning*, 153 USPQ 740 (CCPA 1967). These cases, however, are distinguishable from the facts in the present application.

In *Karlson*, the claims were directed to a chemical feeder that included upwardly extending sides defining a clear and unobstructed interior space within which a supply of soluble chemical may be contained. To reject the claims, the Examiner relied on a reference (Shuldener) that disclosed a chemical feeding tank that included a filler tube for introducing a chemical into the tank and a screen horizontally placed near the tanks’ mid-section. 136 USPQ at 185. Shuldener disclosed that (1) the chemical begins to dissolve as it passes through the tube, and (2) the screen is used to suspend and dissolve any chemical that is not dissolved before it reaches the screen. *Id.* To reject the claims, the Examiner said it would be obvious to eliminate the filler tube and screen from that reference. *Id.* The CCPA affirmed the rejections stating that the cited reference disclosed that (1) the filler tube was only a preferred element that may be provided to confine the solid chemical as it passes through the upper portion of the tank, and (2) the screen would intercept chemicals that do not dissolve by the time they reach the screen, and that in certain circumstances almost all of the chemical would dissolve before reaching the screen. *Id.* That is, the Court found that removing the screen in filler tube from the cited reference would not destroy the structure relied on by Shuldener to execute his invention. 136 USPQ at 186.

In *In re Wilson and Benning*, the claim at issue was for a process of forming an elastomeric polymeric resonance material comprising reacting certain chemicals in the absence of water. The Examiner relied on a reference by Newton that disclosed preparing a resilient cellular foamed elastomeric material by reacting a linear polycarbonate and an organic diisocyanate in the presence of a foam inducing agent such as water. 153 USPQ at 741. To reject the claim, the Examiner stated that it would be obvious to omit water from Newton's reaction when its function as a foaming agent was not desired. *Id.* at 742. While apparently including the disclosure that the foam inducing agent may be water, Newton also included a disclosure that simply stated that the material may be obtained by "effecting the desired reaction between a linear polycarbonate and the organic diisocyanate in the presence of a foam inducing agent." *Id.* at 741. That is, it appears that the foam inducing agent did not necessarily have to be water. Thus, other foaming agents could be used and, similar to *In re Karlson*, eliminating an element - water - from the Newton reference did not destroy the overall configuration relied on by Newton to execute his invention.

Contrary to the facts in *Karlson and Wilson and Benning*, modifying Yang by eliminating the first layer in Yang's baseball is not proper. While finding that certain elements in the Shuldener reference could be eliminated, the Court in *Karlson* recognized that "omission of an element and its function in a combination is an obvious expedient if the remaining elements perform the same function as before." 136 USPQ at 186 (emphasis added). Put another way, *Karlson* recognized that - consistent with the present standards - a reference cannot be modified to eliminate an element and its function if such a modification would (1) change the reference's principle mode of operation, or (2) render the reference's invention unsatisfactory for its intended purpose. See, MPEP 2143.01 (V), (VI).

Unlike the filler tube and screen in Shuldener or the water in Watson, the first, second and third layers in Yang are not merely preferred elements that "may be" provided to provide a function. Yang clearly states that the first and third layers having a hardness less than that of the second layer are necessary to provide a cushioning device. If the first layer in Yang is eliminated, the remaining elements do not perform the same function as before. That is, eliminating the first layer in Yang's baseball destroys the function relied on by Yang to execute his invention. Consequently, eliminating the first layer in Yang is not "an obvious expedient."

Thus, the facts in the present application differ from those in the cases cited by the Examiner. Mainly, in the present case, eliminating an element and function from the Yang reference would destroy the structure relied on by Yang to execute his invention. That is, the remaining elements in Yang would not perform the same function as before. Consequently, modifying Yang by eliminating the first layer renders Yang's baseball unsatisfactory for its intended purpose and destroys the principle mode of operation for that reference. Therefore, there is no motivation to modify Yang to arrive at the present claims. Consequently, claim 1 and any claim dependent therefrom is not *prima facie* obviousness in view of Yang. Applicants request that the rejection be withdrawn.

2. Claim 6 is Not Obvious in View of Yang

Claim 6 depends from claim 1. Therefore, claim 6 is also not obvious in view of Yang for the same reasons that claim 1 is not obvious in view of Yang.

Applicants also note that even if claim 1 would be obvious in view of Yang - which Applicants emphasize it is not - claim 6 is still not obvious in view of Yang. Yang discloses that its second layer has a hardness that is less than the core's hardness but greater than the third layer's hardness. Presumably, if the first layer in Yang is eliminated, then Yang's second layer corresponds to Applicants' first mantle layer, and Yang's third layer corresponds to Applicants' second mantle layer in claim 6. While Applicants' first mantle layer has a hardness that is less than the core's hardness, the second mantle layer set forth in claim 6 has a hardness that is greater or harder than the first mantle layer's hardness. This is opposite of the ball that would result from eliminating Yang's first layer, wherein the third layer has a hardness less than the second layer. Therefore, even if a first layer in Yang could be eliminated, Yang does not teach or suggest the ball set forth in claim 6.

3. Summary Regarding Yang

In view of the above arguments, Applicants submit that there is no motivation to modify Yang and eliminate Yang's first layer to arrive at a softball in accordance with the present claims. Therefore, claims 1 and 6, and any claims dependent therefrom are patentable over Yang. Applicants request that the rejection of claims 1, 6, 11, and 12 be withdrawn.

B. The Claims are Patentable Over the Combination of Yang in view of Talarico

The Examiner rejected claims 2, 4, 5, 7-10, and 14-18 under 35 U.S.C. § 103(a) as being unpatentable over Yang in view of U.S. Patent No. 5,951,420 to Talarico et al. Applicants traverse this rejection.

As previously discussed, there is no motivation to modify Yang to arrive at the present claims. The Examiner only relies on Talarico for teaching that a urethane may be used to form a foamed material. Talarico, however, does not make up for the deficiencies in Yang regarding the structure or configuration of the game ball set forth in the present claims. In particular, Talarico cannot make up for Yang's deficiencies regarding the mantle layers in a game ball. Therefore, the claims are not obvious in view of Yang and Talarico. Applicants request that the rejection be withdrawn.

C. The Claims are Not Obvious in View of the Combination of Yang, Talarico, and Walker

The Examiner rejected claims 3, 12, 13, and 19-21 under 35 U.S.C. § 103(a) as being unpatentable over Yang in view of Talarico and U.S. Patent 5,647,590 to Walker et al. Applicants traverse this rejection.

The Examiner only relies on Walker for teaching that a polyurethane foam may be formed from a mixture of 100 parts polyol and 33-40 parts isocyanate. Walker does not teach a multi-layered game ball and does not make up for the deficiencies in Yang or the combination of Yang and Talarico regarding the structure or configuration of a game ball in accordance with the present claims. Therefore, the claims are not obvious in view of the combination of Yang, Talarico, and Walker. Applicants request that the rejection be withdrawn.

D. New Claims 23-35 are Patentable over the Cited Art

As part of this submission, Applicants add new claims 23-35. New claim 23 is an independent claim reciting a softball comprising a composite core comprising (1) a central core comprising a first urethane composition and having a first hardness, and (2) a first outer core layer adjacent the central core, the first outer core layer comprising a second urethane composition and having a second hardness less than the first hardness. Claim

23 also recites that the softball has a compression of about 400 lbs. or less and a coefficient of restitution of from about 0.400 to about 0.500 at 88 feet /second. Thus, new claim 23 does not limit the core to only a central core and no more than two mantle or core layers. Claims 24-35 directly or indirectly depend from claim 23.

Applicants submit that new claims 23-35 are patentable over the references cited by the Examiner for the reasons previously discussed. Mainly, the references do not teach or suggest a multi-layer softball as set forth in the present claims. While other references may disclose game balls having multi-layered cores, they do not teach or suggest a game ball, such as a softball, having a core comprising a center core having a first hardness, and a first outer core layer adjacent the central core that has a second hardness that is less than the first hardness to provide a same ball having a low compression but desirable COR values. Further, there is simply no motivation for a person skilled in the art to modify the Examiner's primary reference - Yang - to arrive at the present claims.

Therefore, Applicants submit that new claims 23-35 are in condition for allowance.


CONCLUSION

For the reasons detailed above, it is respectfully submitted all claims remaining in the application (Claims 1-11, 13-18, and 20-35) are now in condition for allowance.

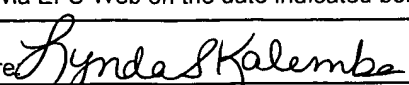
Respectfully submitted,

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August 7, 2006
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